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In re Application of  
Niles R. Rosenquist  
Application No. 10/655,551  
Filed: September 3, 2003  
Atty. Docket No.: 08CL6929-4

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: ORDER TO  
: SHOW CAUSE  
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CENTRAL REEXAMINATION UNIT

This is a show cause order based on the expiration of U.S. patent 5,367,044, while the present application requests reissue of that patent.

### BACKGROUND

1. The present application was filed September 3, 2003 for reissue of U.S. patent 5,367,044 (the '044 patent) issued November 22, 1994.
2. The Office's financial records reveal that the 7.5 year maintenance fee due by May 22, 2002 was not paid by November 22, 2002, the end of the grace period.
3. The Office records reveal that the '044 patent has expired for failure to pay the 7.5 year maintenance fee. See 1266 *Official Gazette* (January 23, 2003).
4. The Office records do not reveal that the '044 patent been subsequently revived, nor do they reflect payment of the 11.5 year maintenance fee, which would have been due by May 22, 2006, had the '044 patent been subsequently revived. The grace period for payment of this fee expires November 22, 2006.

### ORDER TO SHOW CAUSE

As pointed out above, the present reissue proceeding is for reissue of the '044 patent, and Office records reveal that patent to have expired for failure to pay the 7.5 year maintenance fee by November 22, 2002. On December 4, 2001, a Notice of the expiration of the '044 patent was published in the *Official Gazette*. Since the '044 patent has expired for failure to pay the first maintenance fee, the Director of the USPTO no longer has the authority under 35 U.S.C. § 251 to reissue the '044 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, **when Morgan's original patent expired** on August 19, 1992, **the Commissioner was divested of his reissue authority** because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot."

990 F.2d at 1231, 26 USPQ2d at 1393 [Emphasis added]

Because the Director did not have the authority under 35 U.S.C. § 251 to accept and examine the instant application for reissue of the '044 patent, the Office intends to vacate the present reissue proceeding, and thereafter hold the instant application to be an abandoned application as a matter of "housekeeping."

Applicant is hereby being provided with a period of **30 DAYS** from the mailing of this ORDER to show cause why the Office should not vacate the present reissue proceeding.

If applicant proposes to show cause why the present reissue proceeding should not be vacated, applicant's showing must include an explanation of why the proceeding should continue in spite of the expiration of the original patent.

If applicant makes a showing, the showing will be evaluated as to whether it provides sufficient basis why the present reissue proceeding should not be vacated. A failure to present any reasons for not vacating the proceeding within the set 30 day period will result in the proceeding being vacated by default. If the present reissue proceeding is vacated, the application for reissue of the '044 patent will be returned to Technology Center 1700 for processing as an abandoned application.

### CONCLUSION

1. Applicant is being provided with a period of 30 DAYS from the mailing of this ORDER to **show cause why the Office should not vacate the present reissue proceeding.**
2. Failure by applicant to respond to this show cause order within the 30 day period will result in the vacating of the proceeding, followed by a mailing of a Notice of Abandonment in the application.
4. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726 or, in his absence to the undersigned at (571) 272-7710.



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